

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. KRUMWIEDE,
ANTHONY V. LONGOBARDO,
LARRY J. SHELESTAK, and
DAVID R. HASKINS

Appeal No. 98-0770
Application No. 08/529,039

ON BRIEF

Before John D. Smith, Lieberman, and Kratz, Administrative Patent Judges.

Lieberman, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 12, 19, 25 through 28, 32, 33, 35, 36, and 38 through 44 which are all the claims pending in this application.

THE INVENTION

The invention is directed to a neutral gray colored glass composition having a glass portion comprising specified amounts of SiO₂, Na₂O, CaO and the optional presence of other metal oxides. The glass further contains a colorant consisting essentially of specified amounts of Fe₂O₃, FeO, CoO and Se.

THE CLAIM

Claim 1 is illustrative of appellant's invention and is reproduced below.

1. A neutral gray colored glass composition having a base glass portion comprising:

SiO₂
Na₂O
CaO
MgO
Al₂O₃
K₂O

66 to 75 percent by weight
10 to 20 percent by weight
5 to 15 percent by weight
0 to 5 percent by weight
0 to 5 percent by weight
0 to 5 percent by weight

and a colorant portion consisting essentially of:

Fe₂O₃ (total iron)
FeO
CoO
Se

0.6 to 0.935 percent by weight

up to 0.30 percent by weight
60 to 180 PPM
5 to 29 PPM

the glass having a luminous transmittance of 20 to 39.28 percent at a thickness of 3.9 millimeters.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

Pecoraro et al. (Pecoraro) 4,792,536 Dec. 20,
1988

Alvarez-Casariago et al. (Alvarez-Casariago) EP 536 049 Apr. 7,
1993 (Published European Patent Application)

THE REJECTIONS

Claims 1, 3, 9 through 11, 25, 32, 33, 35 and 36 stand rejected under 35 U.S.C. § 102(a), or in the alternative § 102(b), as being anticipated by Alvarez-Casariago.¹

Claims 1 through 12, 25 through 28, 32, 33, 35, 36, and 38 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alvarez-Casariago in view of Pecoraro.

Claim 19 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

OPINION

We agree with the examiner that the rejections under 35 U.S.C. § 102, 35 U.S.C. § 103 and 35 U.S.C. § 112 are well founded for the reasons essentially set forth by the examiner in the Answer. We conclude that Alvarez-Casariago's product anticipates and renders obvious the claimed subject matter. Accordingly, we sustain these rejections.

As an initial matter, the appellants state that the rejected claims stand or fall together with respect to each ground of rejection. Accordingly, we select independent claim 1, as representative of the claimed subject matter for the second and third ground of rejection and limit our consideration thereto. See Brief, page 3. 37 CFR § 1.192 (c)(7)(1995).

The Rejection under 35 U.S.C. § 112

We turn first to the rejection of claim 19 under the second paragraph of § 112. We find that appellants have not challenged the propriety of this rejection. See Brief, page 3. Accordingly, we affirm *pro forma* the examiner's decision rejecting claim 19 under the second paragraph of 35 U.S.C. § 112.

The Alvarez-Casariago Reference

We next turn to the second ground of rejection, that of claim 1 as anticipated by Alvarez-Casariago under § 102. We find that each of the required components of appellants' glass composition is taught by Alvarez-Casariago. We find that Alvarez-Casariago discloses a tinted glass for the fabrication of a window glass on See page 2. We find that the reference discloses glass containing 64 to 75% silicon dioxide, 5 to 15% calcium oxide, and 10 to 18% sodium oxide. See page 3. We further find that the reference discloses coloring agents containing Fe₂O₃ (total iron) in an amount of 0.45 to 2.5%, CoO in an amount of 0.001 to 0.02% corse ppm, Se in an amount of 0 to 0.0025%, corresponding to 0 to 25 ppm, and chromium oxide, Cr₂O₃, in an amount of 0 to 0.1% by weight. See page 3. We further find in the Table on page 4 a total iron content of 0.45 to 1%, a CoO content of 10 to 100 ppm, and a Se content of 2 to 20 ppm.

A determination of anticipation is based on the unique merits (facts) of each case. In the instant case, we are cognizant that the disclosure of Alvarez-Casariago overlaps in range of the claimed invention. However, the overlapped teachings do not negate anticipation. It has been held that, "the disclosure in the prior art

value within a claimed range is an anticipation of the claimed range." *Ex parte Lee*, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993). As we found in our discussion *supra*, Alvarez-Casariago discloses specific values identical with or falling within the claimed range including a value of zero p

of chromium. Hence, we conclude that Alvarez-Casariago anticipates appellants' claimed invention.

We, moreover, agree with the examiner's determination that Example 4 anticipates the claimed subject matter by exemplifying each of the components within the range set forth in the claimed subject matter. We determine that chromium oxide, which is present in an amount of 480 ppm does not negate anticipation. position that the transitional phrase "consisting essentially of" does not exclude the chromium oxide and that the burden of proof rests with the appellants to demonstrate otherwise. See Answer, page 4. We concur with the examiner's determination. See *Ex parte Hoffman*, 12 USPQ2d 1061, 1064 (Bd. Pat. App. & Int. 1991).

¹The record indicates that the prior art qualifies as being available under § 102(a) which in the record was inadvertently omitted from the rejection as stated in the Answer. We note that the record is devoid of a Declaration under 37 CFR § 1.131 antedating the reference of record.

It is well settled that the term "consisting essentially of" includes not only what is specifically recited in appellants' claim, but also any other materials which do not materially affect the basic and novel characteristics of the claimed composition. See PPG Indus., Inc. v. Guardian Indus. Corp., 156 F.

1351, 1354, 48 USPQ2d 1351, 1353-1354 (Fed. Cir. 1998); In re Herz, 537 F.2d 549, 551-552, 190 USPQ 461, 463 (CCPA 1976); In re De Lajarte, 337 F.2d 870, 873-874, 143 USPQ 256, 258 (CCPA 1964); In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963). See In re Herz, *supra*, 537 F.2d 549, 551-552, 190 USPQ 461, 463 (CCPA 1976). "The position of an applicant who has not clearly limited his claims is in a weak position to assert a narrow construction."

In the case at bar, the Board is further of the view that the basic and novel characteristics of the claimed subject matter are defined in terms of a glass having a neutral gray color characterized by a luminous transmittance (LTA) % of 20 to 39.28%, claim 1, and a preferred dominant wavelength (DW) in the range of 480 nanometers. See specification, page 15. The glass is further characterized by a total solar energy transmittance (TSET) % having a range as exemplified in Examples 1 to 68 of 21.42, Example 67 to 45.87, Example 41. Furthermore the basic characteristics established by the appellants include a preferred excitation purity higher than 8%. See specification. Each of these values has been determined for each example of record. See specification, pages 11 to 14.

The appellants have argued that the inclusion of Cr₂O₃ in a soda-lime-silica glass composition in a manner taught by Alvarez-Casariago affects the basic characteristics of the glass. See Brief, page 4. We disagree. We find that the specification permits the presence of chromium. See page 9. Indeed, the examples in specification include up to 13 ppm of chromium oxide. *Id.* Moreover, no upper limit for chromium has been established by the appellants. Nonetheless, in support of their position, the appellants have prepared computer models A and B which are identical in all respects other than Composition A contained 480 ppm of chromium oxide. Brief, page 5. Comparative results are demonstrated in a Table on page 5 of the Brief wherein of the basic and novel characteristics of the glass are compared.

We find that the comparative example discussed in the Brief on page 5, Composition A, shows that the physical characteristics tabulated therein fall within the scope of the claimed subject matter. Thus, the LTA% transmittance falls within the 20 to 39.28% of claim 1. The excitation purity of 5.61% is within the scope of maximum of 8% provided in the specification, page 15. In addition, we previously found that a neutral gray color is characterized by a dominant wavelength of 480 to 580 nanometers. The comparative example discloses a dominant wavelength of 501 nanometers which is well within this range. See specification, page 15. Finally, the TSET, total solar energy transmission of the comparative example falls within the scope of Examples 1 to 68 appearing on pages 11-14 of the specification. We conclude that the evidence presented by the appellants unequivocally establishes that the presence of chromium oxide does not affect the basic and novel characteristics of the composition.

Based upon the above considerations, we conclude that the examiner has established a *prima facie* case of anticipation against the claimed subject matter before us.

We shall also sustain the rejection under 35 U.S.C. § 103. Appellants have stated in the Brief, page 3, that the rejected claims stand or fall together with respect to the second and third grounds of rejection, and we have previously affirmed the § 102 rejection of independent claim 1 as being anticipated by Alvarez-Casariago. It is well settled that the ultimate of obviousness, is lack of novelty. The claims cannot have been anticipated and not have been obvious. In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). Accordingly, there is no further need to inquire into the disclosure of Alvarez-Casariago.

DECISION

The rejection of claims 1, 3, 9 through 11, 25, 32, 33, 35 and 36 under 35 U.S.C. § 102, as being anticipated by Alvarez-Casariago is affirmed.

The rejection of claims 1 through 12, 25 through 28, 32, 33, 35, 36, and 38 through 44 under 35 U.S.C. § 103 as being unpatentable over Alvarez-Casariago in view of Pecoraro is affirmed.

The rejection of claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

<small>JOHN D.</small> SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
<small>PAUL LIEBERMAN</small>)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)	
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